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EXAMINER

HEWITT, JAMES M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/569,559	Applicant(s) STOLLE ET AL.	
	Examiner JAMES M. HEWITT	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/6/09, 7/22/09 & 11/9/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-25 is/are pending in the application.
- 4a) Of the above claim(s) 17-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 4-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 17-25 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The product as claimed can be made by another and materially different process (MPEP § 806.05(f)), said process comprising “threading a connection collar onto the second component” and “threading the connection collar onto the first component after the first component abuts the second component to maintain the pre-defined axial alignment by the connection collar being threaded onto the first set of threads and the second set of threads.” or the process as claimed can be used to make another and materially different product, said product not having threads on the ends of the components.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 17-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Information Disclosure Statement

Note that all documents listed in the IDS filed 2/27/06 have been considered.

Drawings

The drawings are objected to because the embodiment described on lines 1-6 of page 12 of the specification should be shown (note that the replacement sheet removed the illustration of said embodiment). Each embodiment should be represented in a different figure (e.g. FIGS. 5A-C). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Note that the specification should be amended so as to be in accord with any drawing amendment.

Specification

The abstract of the disclosure is objected to because the claimed invention which it describes does not include methods. Correction is required. See MPEP § 608.01(b).

The title of the application is objected to as it erroneously describes the claimed invention as including methods.

Appropriate correction is required.

Claim Objections

Claim 11 is objected to because of the following informalities:

On lines 2, 4, 6 and 8, "potion" should be "portion".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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In claim 9, reciting that the respective threads are “associated with” each component constitutes new matter not supported by the original disclosure. The original disclosure only supports the threads being on each component.

In claim 14, the phrase “...and any combination thereof” constitutes new matter not supported by the original disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 4-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preambles of each of claims 1, 6, 7 and 8 each functionally recite a first component and a second component. Yet the body of each claim positively recites the first and second components, thus making it unclear as to whether the first and second components are being positively claimed.

For examination purposes, the first and second components are considered to be positively claimed as part of the invention.

In claim 8, part “C.” does not accurately characterize the invention and is not in accord with the disclosure’s description of the claimed embodiment. It seems at least as if instances of “first component connection end” should be “second component connection end” and vice versa.

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In claim 9, it is unclear as to what is meant by reciting that the threads are “associated with” each component.

In claim 14, line 1, “the one or more passages” lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-5, 6-7, 9-10 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hughes (US 5,950,744).

Hughes discloses a pipe joint for self aligning a drill string, tubing string or casing string of the type comprising a plurality of drill pipe, tubing or casing sections arranged in end to end relation from a location above the ground to a lower location adjacent a tool connected to a bottom end of the string and wherein the adjacent ends of the sections are connected to each other to form a plurality of spaced joints extending downwardly from the ground to the tool, the improvement wherein each joint comprises an upper section having at least one downwardly projecting extension and a lower section having a corresponding recess for receiving the extension and wherein the extension and the recess can fit together in only one way.

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Hughes employs pins, legs and keys (spacers/nipples) that mate corresponding recesses and slots (openings/nipple recipients) in order to align and join the sections in one way.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (US 5,950,744).

As to claim 11, Hughes fails to teach that both of the components are notched. Yet it would have been an obvious matter of design choice to notch both of Hughes' components since Applicant has attributed no absolute criticality to notching both components and states "Additionally first component 10 and second component 20 can be fabricated such that there is essentially no external diameter upset (i.e., there is substantially constant external diameter across the connection)."

As to claim 12, Hughes fails to teach that the components are covered with a suitable coating to protect from galling or corrosion. Examiner takes official notice of the provision of coatings on oil country tubular goods, and accordingly it would have been

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obvious to one having ordinary skill in the art to provide a suitable coating on Hughes' components in order to protect the components from galling or corrosion.

As to claim 15, Hughes fails to teach a first seal configured to be disposed between the first component and the connection collar; and a second seal configured to be disposed between the second component and the connection collar, wherein the first seal and second seal isolate the first set of threads and the second set of threads from a region external to connection collar. Examiner takes official notice of the use of seals between threaded components in order to isolate the threads. Accordingly, it would have been obvious to one having ordinary skill in the art to modify Hughes to provide a first seal configured to be disposed between the first component and the connection collar; and a second seal configured to be disposed between the second component and the connection collar in order to isolate the first set of threads and the second set of threads from a region external to connection collar.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes (US 5,950,744) in view of Hughes (US 2005/0023831 A1).

Hughes '744 fails to teach a plurality of openings in the first component and a plurality of openings in the second component, wherein the first plurality of openings and the second plurality of openings align to form one or more passages through the first component and the second component. Hughes '831 teaches a similar drill pipe joint that employs openings in a first component and a plurality of openings in the second component for wire or other material for transmitting power and data between

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the joined sections, wherein the first plurality of openings and the second plurality of openings align to form one or more passages through the first component and the second component. Refer to FIGS. 22-28 and [00710-[0072]. Accordingly, it would have been obvious to one having ordinary skill in the art to modify Hughes '733 with a plurality of openings in the first component and a plurality of openings in the second component for wire or other material, wherein the first plurality of openings and the second plurality of openings align to form one or more passages through the first component and the second component as taught by Hughes '831 in order to transmit power and data between the joined sections.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES M. HEWITT whose telephone number is (571)272-7084. The examiner can normally be reached on M-F, 930am-600pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James M Hewitt/
Primary Examiner, Art Unit 3679